

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Chung Shih, et al.
Serial No: 09/431,519
Filing Date: November 1, 1999
Title: Improved Growth Stimulant Compositions
Confirmation No: 8808
Group Art Unit: 1615
Examiner: Neil S. Levy
Attorney Ref: 1998.433 US3

December 4, 2008

**REQUEST FOR RECONSIDERATION OF
THE PATENT TERM ADJUSTMENT IN THE NOTICE OF ALLOWANCE**

Mail Stop Patent Ext.
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir/Madam:

Applicants request reconsideration of the patent term adjustment in the October 1, 2008 notice of allowance for the above-referenced patent application. In support of this request, Applicants state the following pursuant to 37 C.F.R. §1.705(b):

I. Payment of 37 C.F.R. §1.18(e) fee pursuant to 37 C.F.R. §1.705(b)(1)

Applicants authorize the Commissioner to charge Deposit Account No. 02-2334 for the fee under 37 C.F.R. §1.18(e).

II. Statement of facts involved pursuant to 37 C.F.R. §1.705(b)(2)

i. Correct patent term adjustment

The October 1, 2008 notice of allowance indicates that the total patent term adjustment should be zero days, based on a finding of 31 days of PTO delay offset by 691 days of Applicant delay. The Patent Office appears to have made this calculation by adding the Patent Office delay occurring during the entire period after Applicants' February 11, 2002 continued prosecution application ("CPA") filing date, and then offsetting that delay with its finding of Applicant delay during that same period. Applicants respectfully submit that the Patent Office's calculation is

incorrect, particularly in view of *Wyeth v. Dudas* (07-1492 (D.D.C 2008)). More specifically, Applicants respectfully submit that the patent term adjustment should be calculated as follows:

- A. ***Term adjustment under 37 C.F.R. §1.703(a): Any Patent Office delay during the first 3 years following Applicants' February 11, 2002 CPA filing that is not offset by Applicant delay during that same period.***

PLUS

- B. ***Term adjustment under 37 C.F.R. §1.703(b): The time period from the 3-year anniversary of Applicants' February 11, 2002 CPA filing date to Applicants' July 14, 2005 RCE filing date offset by Applicant delay during that same period.***

In the above equation, Applicants believe the term adjustment under 37 C.F.R. §1.703(a) to be zero days, based on a 31-day Patent Office delay and a 43-day Applicant delay between the February 11, 2002 CPA filing date and its February 11, 2005 three-year anniversary. Applicants, however, believe that the term adjustment under 37 C.F.R. §1.703(b) to be 69 days. Accordingly, Applicants respectfully submit that the total patent term adjustment is 69 days, *i.e.*, the sum of the term adjustments under 37 C.F.R. §1.703(a) and 37 C.F.R. §1.703(b).

- ii. *Relevant dates as specified in 37 C.F.R. §§1.703(a) through (e) for which an adjustment is sought and the adjustment as specified in 37 C.F.R. §1.703(f) to which the patent is entitled*

The following table provides the dates Applicants believe are relevant to calculate the patent term adjustment:

DATES OF ACTIVITIES DURING FIRST 3 YEARS AFTER CPA FILING (RELEVANT TO CALCULATION UNDER 37 C.F.R. §1.703(a))		
	Date	Days added to term
Applicants filed a continued prosecution application (CPA)	02/11/02	---
Patent Office mailed a non-final Office action	03/18/02	---
Applicants filed a response to the 03/18/02 non-final Office action	06/24/02	(6)
Applicants filed an appeal brief	02/21/03	---
Patent Office re-opened examination by mailing a non-final Office action in response to 02/21/03 appeal brief	07/22/03	31

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DATES OF ACTIVITIES DURING FIRST 3 YEARS AFTER CPA FILING (RELEVANT TO CALCULATION UNDER 37 C.F.R. §1.703(a))		
	Date	Days added to term
Applicants filed a response to the 07/22/03 non-final Office action	11/28/03	(37)
Patent Office mailed a final Office action	02/23/04	---
Patent Office received 02/23/04 final Office action that was returned to Patent Office by Postal Service	03/08/04	---
Patent Office mailed notice of abandonment for failure to respond to 02/23/04 final Office action	09/24/04	---
Patent Office mailed notice of rescinded abandonment and restarted period for responding to 02/23/04 final Office action	12/16/04	---
Three-year anniversary of Applicants' 02/11/02 CPA filing date (at this point, Applicants had not filed a response to the 02/23/04 final Office action)	02/11/05	---
TOTAL ADJUSTMENT UNDER 37 C.F.R. §1.703(a))		ZERO

DATES AFTER THE 3-YEAR ANNIVERSARY OF THE CPA FILING (RELEVANT TO CALCULATION UNDER 37 C.F.R. §1.703(b))		
Activity	Date	Days added to term
Three-year anniversary of Applicants' CPA filing date	02/11/05	---
Three months after the Patent Office restarted the period for responding to the 02/23/04 final Office action	03/16/05	---
Applicant filed Notice of Appeal in response to 02/23/04 final Office action	06/07/05	(83)
Request for continued examination (RCE) filing date	07/14/05	152
TOTAL ADJUSTMENT UNDER 37 C.F.R. §1.703(b))		69

The sum of total adjustments under 37 C.F.R. §1.703(a)) and 37 C.F.R. §1.703(b)) is 69 days.

iii. No terminal disclaimer in this patent application

No terminal disclaimer has been filed for this patent application.

iv. Circumstances constituting a presumption in the failure to engage in reasonable efforts to conclude processing or examination

Applicants do not concur with the Patent Office's findings of Applicant delay.

Applicants respectfully submit that the total adjustments under 37 C.F.R. §1.703(a)) and 37 C.F.R. §1.703(b)) must be calculated separately under *Wyeth v. Dudas* (07-1492 (D.D.C 2008)).

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In addition, Applicants respectfully submit that their delay is less than the delay calculated by the Patent Office. Specifically, Applicants believe that the Applicant delay during the first three years following their February 11, 2002 CPA filing date totals 43 days:

- (1) a 6-day delay in responding to the 03/18/02 non-final Office action; and
- (2) a 37-day delay in responding to the 07/22/03 non-final Office action.

And Applicants submit that their delay between the third anniversary of their CPA filing and the filing of their July 14, 2005 RCE is the 83-day delay in responding to the February 23, 2004 final Office action.

In its calculations on Public PAIR, the Patent Office indicates that Applicants delayed 380 days in responding to the February 23, 2004 final Office action. Applicants, however, respectfully submit that there was no Applicant delay before March 17, 2005 with respect to that Office action. Specifically, the Patent Office's attempt to mail the February 23, 2004 final Office action appears to have failed, and the Patent Office appears to have been notified of this on March 8, 2004. The Patent Office subsequently restarted the response period on December 16, 2004, which extended the response period to March 16, 2005. Thus, Applicants respectfully submit that their only delay in responding to the February 23, 2004 final Office action occurred between March 17, 2005 and their filing of a Notice of Appeal on June 7, 2005. As noted above, that delay is 83 days.

The Undersigned cautions that the above analysis is based on information that the Undersigned obtained from Public PAIR. None of the representations, including those with respect to the February 23, 2004 Office action, are based on firsthand knowledge.

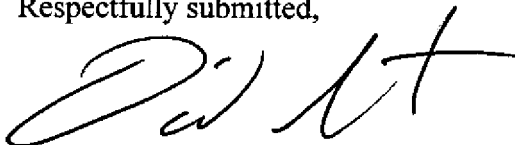
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Applicants do not believe that any fee is due in connection with this filing other than the 37 C.F.R. §1.18(e) fee paid above. If, however, Applicants do owe any such additional fee(s), the Commissioner is hereby authorized to charge the fee(s) to Deposit Account No. **02-2334**. In addition, if there is ever any other fee deficiency or overpayment in connection with this patent application, the Commissioner is hereby authorized to charge such deficiency or overpayment to Deposit Account No. **02-2334**.

The Patent Office is requested to call the Undersigned if any issues arise that can be addressed over the phone to expedite resolution of this request.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read 'D. Gryte', with a long horizontal stroke extending to the right.

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